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JUL 07 2008

OFFICE OF PETITIONS

In re Application of	:	
Kubota et al.	:	
Application No.: 10/615289	:	DECISION ON
Filing or 371(c) Date: 07/09/2003	:	PETITION
Attorney Docket Number: 03500.017379	:	

This is a decision in response to the Request for Withdrawal of Erroneous Notice of Abandonment, Contingent Petition for Withdrawal of Notice of Abandonment, and Resubmission of Amendment which was Deemed to be Non-Compliant," May 8, 2008. The petition is properly treated as a Petition To Withdraw Holding of Abandonment under 37 CFR 1.181.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Noncompliant Amendment ("Notice"), mailed August 29, 2007. The Notice set a one (1) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). Applicant filed a reply to the Notice on October 25, 2007; however, the reply was not a complete and proper reply. No complete and proper reply having been received, the application became abandoned on September 30, 2007. A Notice of Abandonment was mailed April 8, 2008.

The Notice of Abandonment provides the following background: A first Notice of Noncompliant Amendment was mailed March 15, 2005, requiring replacement drawings and an amendment in compliance with 37 CFR 1.121. Applicants filed a response on April 18, 2005, with another non-compliant amendment. The amendment was non-compliant because the specification did not include marked-up paragraphs. Marked up paragraphs were included in "Applicant's Arguments/Remarks Made in an Amendment." Also noted was that the claims were not separately listed.

A second Notice of Noncompliant Amendment was mailed May 31, 2007, but listed only the failure to separately list all claims as the reason for noncompliance. The second Notice did not

mention the failure to present replacement drawings. The second Notice also did not mention that marked up paragraphs were included in "Applicant's Arguments/Remarks Made in an Amendment," instead of the specification.

Applicant's responded to the second Notice on June 8, 2007, with another non-responsive amendment and no replacement drawings. Applicants presented a clean copy of the amended specification for amendment, and with their remarks set forth the marked up paragraphs. No amendment to the specification in compliance with 37 CFR 1.121 was filed on June 18, 2007.

A third Notice of Noncompliant Amendment was mailed On August 29, 2007 requiring replacement drawings and a proper amendment to the specification. Applicants filed a response on October 25, 2007; however, again failed to file a proper amendment to the specification. Instead, Applicants argued that the marked up paragraphs filed June 8, 2007 were sufficient to amend the specification.

Petition under 37 CFR 1.181

Applicant files the present petition and states, in relevant part, that "it was realized for the first time that what the examiner was requesting was [their] version of the January 3, 2005 Amendment, wherein the changes to the equations appeared with their entire paragraphs in the body of the Amendment showing to corrections therein, rather than in the attached marked up sheets. Petition at p.2.

Applicable Law, Rules and MPEP

37 CFR 1.135, Abandonment for failure to reply within time period, provides that

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

MPEP 711.03(c)

Analysis and conclusion

The application became abandoned for failure to timely reply to the final Office action. Applicant has failed to demonstrate that a complete and proper reply to the office action was filed. Applicant admits that after this Office issued the Notice of Abandonment, it realized for the first time what the Examiner was requesting. While Applicants have demonstrated that timely replies to the Notices were filed, the Replies were not complete and proper.

Applicant is advised that, as provided in the Manual of Patent Examining Procedure,

[w]here an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

MPEP 711.03(c).

Here, there is no dispute as to the sufficiency of the reply. Applicant acknowledges that it was realized for the first time that what the examiner was requesting was [their] version of the January 3, 2005 Amendment, wherein the changes to the equations appeared with their entire paragraphs in the body of the Amendment showing to corrections therein, rather than in the attached marked up sheets. There is no dispute as to whether the application is abandoned, Applicant's contentions merely involve the cause of abandonment. A petition to revive the application (and fee) is the appropriate course of action. The holding of abandonment is proper, and will not be withdrawn.

Alternative venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.


The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Director for Patents PO Box 1450 Alexandria, VA 22313-1450
By FAX:	(571) 273-8300 Attn: Office of Petitions
By hand:	Customer Service Window Randolph Building 401 Dulany Street

Alexandria, VA 22314

Telephone inquiries concerning the Amendment should be directed to the Examiner. Questions regarding this decision should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions